

**REMARKS**

Claims 1-9, 11-38, 40, 50, 55, 60, and 80-87 are pending. Claim 55 is withdrawn from consideration. No new claims have been added, claims 7, 8, 32, 33, 40, 80-82 and 87 have been canceled without prejudice, and claims 1, 2, 6, 11, 12, 23, 31, 38, 50 and 60 have been amended herein to define Applicants' invention with greater particularity. Claims 1, 2, 11, 11, 12, 23, 38, 50 and 50 have been amended to correct a typographical error. Support for the amended claims may be found, among others, in the specification at page 27, lines 8-10. No new matter has been added with the Amendments, being fully supported by the specification and claims as originally filed. Upon entry of this communication, claims 1-6, 9, 11-31, 34-38, 50, 60, and 83-86 will be under consideration.

**Rejection under 35 U.S.C. § 112, First Paragraph**

Applicants respectfully traverse the rejection of claims 1-9, 11-15, 18-28, 30-38, 40, 60 and 83-87 under 35 U.S.C. § 112, first paragraph, as allegedly failing to enable one of skill in the art to make and use the invention commensurate in scope with the claims. Specifically, the Examiner alleges that the claimed methods wherein the methods are performed in cells that are *in vivo* or for a non-isolated cell. However, the Examiner indicated that "limiting the claims to methods that are performed *in vitro* as well as limiting the "host cell" to an isolated host cell would obviate this rejection." (Office action, page 9, last paragraph). Applicants have canceled claims 7, 8, 32, 33, 40 and 87, rendering the rejection moot as to those claims. In order to limit the issues and further prosecution, Applicants have amended claims 1, 23, 38 and 60 to limit the pending claims to methods that are performed *in vitro* and to an isolated host cell, and preserve the right to pursue all canceled subject matter in a continuing application. Accordingly, Applicants respectfully request withdrawal of the rejection.

Applicants respectfully traverse the rejection of claims 1-9, 11-38, 40, 50, 60 and 80-87 under 35 U.S.C. § 112, First Paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner alleges that the claims encompass a destabilization domains that are ubiquitin homologs at least 85% identical to the amino acid

sequence of wild-type ubiquitin, and that claim 11 also encompasses homologs of a naturally fluorescent protein. Applicants have canceled claims 7, 8, 32, 33, 40, 80-82 and 87, rendering the rejection moot as to those claims. In order to limit the issues and further prosecution, Applicants have amended claims 6, 11, 31, 38, 50 and 60 to limit the claims to destabilization domains comprising a mutation at glycine 76 of the amino acid sequence of wild-type ubiquitin, and to naturally fluorescent proteins. Accordingly, Applicants respectfully request withdrawal of the rejection.

Therefore, for the reasons set forth above, it is respectfully submitted that claims 1-6, 9, 11-31, 34-38, 50, 60, and 83-86 satisfy the enablement and the written description requirements under 35 U.S.C. § 112, first paragraph, and withdrawal of the rejection is respectfully requested.

In re Application of:  
Stack et al.  
Application No.: 09/498,098  
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PATENT  
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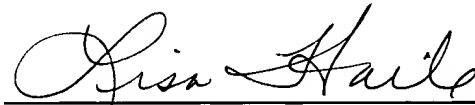
### **CONCLUSION**

In summary, for the reasons set forth herein, Applicants maintain that claims 1-6, 9, 11-31, 34-38, 50, 60, and 83-86 clearly and patentably define the invention and respectfully request that the Examiner withdraw all rejections and pass the application to allowance. If the Examiner would like to discuss any of the issues raised in the Office Action, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application can be achieved.

Enclosed is Check No. 579908 in the amount of \$430.00 for the two (2) months extension of time fee. The Commissioner is hereby authorized to charge any other fees associated with the filing submitted herewith, or credit any overpayments to Deposit Account No. 07-1896.

Respectfully submitted,

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